

Appl. No. : 09/988,728
Filed : November 16, 2001

REMARKS

Applicant has the following comments and remarks in response to the Office Action.

Discussion of Objections to the Specification

In the Office Action, objected to lack of antecedent basis for Claim 13 in the specification. Applicant respectfully submits that this has been corrected by the above-amendments.

Discussion of Claim Rejections Under 35 U.S.C. §and 103(a)

In the Office Action, the Examiner rejected Claims 1-9, 12-15, 17-22, and 3031 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,143,247, to Sheppard, Jr., et al. (hereinafter "Sheppard") in view of U.S. Patent No. 5,962,238, to Sizto, et al (hereinafter "Sizto"). The Examiner rejected Claims 10 and 11 under 35 U.S.C. § 103(a) as being unpatentable over Sheppard in view Sizto in view of U.S. Patent No. 5,812,419, to Chupp, et al. (hereinafter "Chupp"). Claim 16 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Sheppard in view in view of Sizto of U.S. Patent No. 4,307,367, to Miller, et al. (hereinafter "Miller"). Claims 19 and 20 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Sheppard.

Applicant respectfully submits that to establish a *prima facie* case of obviousness a three-prong test must be met. First, there must be some suggestion or motivation, either in the references or in the knowledge generally available among those of ordinary skill in the art, to modify the reference. Second, there must be a reasonable expectation of success found in the prior art. Third, the prior art reference must teach or suggest all the claim limitations. *In re Vaeck*, 947 F.2d 488 (Fed. Cir. 1991). Applicant respectfully submits that the cited prior art fails to teach or suggest all of the above-listed claim limitations.

One embodiment of Applicant's invention comprises a rotatable bio-disc. In one embodiment, the bio-disc includes an inlet port for receiving samples and a vent port. Turning to Claim 1, as amended, it is seen that it recites: "providing a sample of cells in a chamber in a disc, the chamber including at least one capture zone with a capture agent, the disc including at least one inlet port and a vent port on a first surface of the disc." In the Office Action, the Examiner relied upon Sheppard as teaching the usage of a bio-disc. Figure 2 illustrates the configuration of

Appl. No. : **09/988,728**
Filed : **November 16, 2001**

the bio-disc of Sheppard. As may be seen, Sheppard fails to teach or suggest the usage of a vent port. Since the cited references fail to teach or suggest at least this limitation, Applicant respectfully submits that this claim is in condition for allowability.

Claims-22, 29 and 30-33

Since Claims 2-21, 29 and 30 each depend on Claim 1, Applicant respectfully submits that they are allowable for the reasons discussed above and the subject matter of their own limitations.

Furthermore, Claim 32 recites: "wherein the disc comprises a first layer of streptavidin, a first antibody raised in a first species against a type of immunoglobulin of a second species, and a second antibody raised in the second species against a cell surface antigen." Applicant respectfully submits that this is not taught or suggested by the cited prior art.

Furthermore, Claim 33 recites: "wherein each of the capture zones are sequentially located in a fluid path between the inlet port and the vent port, and wherein a capture zone is sequentially provided for CD4, CD8 and a control with respect to the fluid path." Applicant respectfully submits that this is not taught or suggested by the cited prior art.

Discussion of Provisional Double Patenting Rejections

In the Office Action, the Examiner made a number of provisional double patenting rejections. Applicant respectfully submits that this rejection will be addressed if these rejections become non-provisional. Applicant notes that the references relied in the provisional double-patenting rejection relates to patents that are not owned by assignee. Thus, it is improper to make this type of rejection. *See* M.P.E.P. M.P.E.P. § 804.

Summary

Applicant has endeavored to address all of the Examiner's concerns as expressed in the outstanding Office Action. Accordingly, amendments to the claims for patentability purposes, the reasons therefore, and arguments in support of the patentability of the pending claim set are presented above. Any claim amendments which are not specifically discussed in the above remarks are not made for patentability purposes, and the claims would satisfy the statutory requirements for patentability without the entry of such amendments. In addition, such

Appl. No. : 09/988,728
Filed : November 16, 2001

amendments do not narrow the scope of the claims. Rather, these amendments have only been made to increase claim readability, to improve grammar, and to reduce the time and effort required of those in the art to clearly understand the scope of the claim language. In light of the above amendments and remarks, reconsideration and withdrawal of the outstanding rejections is specifically requested. If the Examiner has any questions which may be answered by telephone, he is invited to call the undersigned directly.

Respectfully submitted,

KNOBBE, MARTENS, OLSON & BEAR, LLP

Dated: 3/22/2005

By: 

Eric M. Nelson
Registration No. 43,829
Attorney of Record
Customer No. 20,995
(619) 235-8550

1433495_1:sad
032205